



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/035,746	02/25/2011	Bruce Macmillan	MAC-101	3475

32205 7590 02/07/2018
Patti & Malvone Law Group, LLC
One North LaSalle St., 44th Floor
Chicago, IL 60602

EXAMINER

REFAI, RAMSEY

ART UNIT	PAPER NUMBER
----------	--------------

3627

NOTIFICATION DATE	DELIVERY MODE
-------------------	---------------

02/07/2018

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

info@pattimalvoneig.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte BRUCE MACMILLAN

Appeal 2016-004670¹
Application 13/035,746²
Technology Center 3600

Before NINA L. MEDLOCK, TARA L. HUTCHINGS, and
ROBERT J. SILVERMAN, *Administrative Patent Judges*.

MEDLOCK, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1, 3–14, 17–29, and 40–43. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ Our decision references Appellant's Appeal Brief ("App. Br.," filed September 14, 2015) and Reply Br. ("Reply Br.," filed April 5, 2016), and the Examiner's Answer ("Ans.," mailed February 9, 2016) and Final Office Action ("Final Act.," mailed July 7, 2015).

² Appellant identifies the inventor, Bruce Macmillan, as the real party in interest. App. Br. 3.

CLAIMED INVENTION

Appellant's claimed invention "relates generally to methods and apparatus for providing product information" (Spec. 1).

Claims 1, 14, 28, and 29 are the independent claims on appeal.

Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A computer-implemented method of facilitating comparing and verifying of information, the method comprising:
 - receiving, by a computer system, information relating to products and product supply chain operations from one or more sources, said one or more sources comprising at least one of a trusted third-party information provider and an entity associated with said products and product supply chain operations, said entity being one of a manufacturer, a supplier, or a distributor of manufactured products, and said information from the entity identifying the entity and including information about the entity;
 - validating, by the computer system, the information received from the entity about itself based at least in part on the information received from the at least one trusted third-party information provider;
 - responsive to successful validation of the information received from the entity about itself, providing, by the computer system, a plurality of unique identifiers to the entity, said unique identifiers uniquely identifying product items, for association by that entity with those product items;
 - receiving information relating to an individual product item and a corresponding supply chain operation from said entity associated with said individual product item and said corresponding supply chain operation, the information relating to said individual product item including an identifier from the plurality of identifiers provided to said entity;
 - storing and associating, by the computer system, the information received from said one or more sources with the information received from said entity in a database of said computer system;

receiving, by the computer system, a request for information from a potential purchaser of said individual product item, said request including said identifier;

looking up in real time, by the computer system, in the database information associated with said individual product item, using said identifier; and

transmitting in real time, by the computer system, at least part of said information associated with said individual product item to said potential purchaser.

REJECTION

Claims 1, 3–14, 17–29, and 40–43 are rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter.

ANALYSIS

Under 35 U.S.C. § 101, an invention is patent-eligible if it claims a “new and useful process, machine, manufacture, or composition of matter.” 35 U.S.C. § 101. The Supreme Court, however, has long interpreted § 101 to include an implicit exception: “[l]aws of nature, natural phenomena, and abstract ideas” are not patentable. *See, e.g., Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2354 (2014).

The Supreme Court, in *Alice*, reiterated the two-step framework previously set forth in *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 566 U.S. 66 (2012), “for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts.” *Alice Corp.*, 134 S. Ct. at 2355. The first step in that analysis is to “determine whether the claims at issue are directed to one of those patent-ineligible concepts.” *Id.* If the claims are not directed to a patent-ineligible concept, e.g., an abstract idea,

the inquiry ends. Otherwise, the inquiry proceeds to the second step where the elements of the claims are considered “individually and ‘as an ordered combination’” to determine whether there are additional elements that “‘transform the nature of the claim’ into a patent-eligible application.” *Id.* (quoting *Mayo*, 566 U.S. at 79, 78).

The Court acknowledged in *Mayo*, that “all inventions at some level embody, use, reflect, rest upon, or apply laws of nature, natural phenomena, or abstract ideas.” *Mayo*, 566 U.S. at 71. Therefore, the Federal Circuit has instructed that claims are to be considered in their entirety to determine “whether their character as a whole is directed to excluded subject matter.” *McRO, Inc. v. Bandai Namco Games Am., Inc.*, 837 F.3d 1299, 1312 (Fed. Cir. 2016) (quoting *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1346 (Fed. Cir. 2015)).

Here, in rejecting the claims under 35 U.S.C. § 101, the Examiner finds that the pending claims are directed to “providing product information,” i.e., to a fundamental economic practice and a method of organizing human activities and, therefore, to an abstract idea; and that the claims do not recite limitations that are “‘significantly more’ than the abstract idea because the claims do not recite an improvement to another technology or technical field, an improvement to the functioning of the computer itself, or meaningful limitations beyond generally linking the use of an abstract idea to a particular technological environment” (Final Act. 4).

Addressing the first step of the *Mayo/Alice* framework, Appellant notes that each of independent claims 1, 14, 28, and 29 recites “in real time,” i.e., “looking up in real time . . . information associated with [an] individual product item” and “transmitting in real time . . . at least part of [the]

information . . . to [a] potential purchaser,” as recited in claim 1 and similarly recited in claims 14, 28, and 29 (App. Br. 14). And Appellant asserts that “[t]he claims’ recitation of ‘in real time’ renders moot the Examiner’s suggestion” that the claims are directed to a fundamental economic practice and a method of organizing human activities (*id.* at 15). Appellant maintains that providing product information to a potential purchaser in real-time is not an abstract idea (*id.* at 15). But we fail to see how or why, and Appellant does not explain how or why, the recitation that product information is gathered and conveyed in real-time adds anything to the abstract idea of “providing product information” beyond merely qualifying the timing of the data-gathering and conveying operations, i.e., the “looking up,” and transmitting steps. *Cf. Elec. Power Grp. LLC v. Alstom, S.A.*, 830 F.3d 1350, 1354 (Fed. Cir. 2016) (finding claims to a system and method for performing real-time performance monitoring of an electric power grid by collecting data from multiple data sources, analyzing the data, and displaying the results were directed to an abstract idea because “[t]he advance they purport to make is a process of gathering and analyzing information of a specified content, then displaying the results, and not any particular assertedly inventive technology for performing those functions.”).

Appellant argues that providing product information to a potential purchaser in real time is “**only possible on a computer**” (*id.* at 15–16; *see also* Reply Br. 4–5). Yet, claims to an abstract idea are not made less abstract simply because a computer is required.

We find no indication in the Specification, nor does Appellant point to any indication, that any specialized hardware or inventive computer components are required or that the claimed invention is implemented using

other than generic computer components to perform generic computer functions, i.e., receiving, processing, storing, and transmitting information. And, as the Supreme Court made clear in *Alice*, the recitation of generic computer limitations does not make an otherwise ineligible claim patent-eligible. *See Alice Corp.*, 134 S. Ct. at 2358 (holding that if a patent’s recitation of a computer amounts to a mere instruction to implement an abstract idea on a computer, that addition cannot impart patent eligibility).

Appellant asserts that the claims require a computer to perform functions that are “far from being well-understood, routine, and conventional,” as evidenced by the fact that the only rejection is under § 101 (App. Br. 16). Yet, to the extent Appellant maintains that the claimed invention is patent-eligible and/or that the recited functions are not “well-understood, routine, and conventional activities” because the claims are allegedly novel and/or non-obvious in view of the prior art (*id.* at 16–18; *see also* Reply Br. 4–5, 10), Appellant misapprehends the controlling precedent.

A finding of novelty or non-obviousness does not automatically lead to the conclusion that the claimed subject matter is patent-eligible. Although the second step in the *Mayo/Alice* framework is termed a search for an “inventive concept,” the analysis is not an evaluation of novelty or non-obviousness, but rather, a search for “an element or combination of elements that is ‘sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself.’” *Alice Corp.*, 134 S. Ct. at 2355. “Groundbreaking, innovative, or even brilliant discovery does not by itself satisfy the § 101 inquiry.” *Ass’n. for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U.S. 576, 591 (2013). A novel and non-obvious claim directed to a purely abstract idea is, nonetheless, patent-

ineligible. *See Mayo*, 566 U.S. at 90. *See also Diamond v. Diehr*, 450 U.S. 175, 188–89 (1981) (“The ‘novelty’ of any element or steps in a process, or even of the process itself, is of no relevance in determining whether the subject matter of a claim falls within the § 101 categories of possibly patentable subject matter.”).

We are not persuaded, on the present record, that the Examiner erred in rejecting claims 1, 3–14, 17–29, and 40–43 under 35 U.S.C. § 101. Therefore, we sustain the Examiner’s rejection.

DECISION

The Examiner’s rejection of claims 1, 3–14, 17–29, and 40–43 under 35 U.S.C. § 101 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED